

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Nielsen et al.	Art Unit:	3772
Serial No.:	10/550,734	Examiner:	Jackson
Filed:	26 Sep 2005	Conf. No.:	8354
Title:	Wound Dressing		

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Honorable Commissioner for Patents
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Via EFS-Web

Request for Pre-Appeal Brief Conference

This communication is in response to a Final Office Action mailed on July 23, 2009 and is being filed concurrently with a Notice of Appeal.

Applicant respectfully asserts that the rejection of pending claims 11-24 under 35 USC 103(a) is improper on its face and fails to set forth a prima facie case of obviousness. Applicant relies upon the record for a background discussion of the invention as claimed, the rejections, and the cited references.

In summary, the references proffered to support the rejection of record fail to establish

- 1) a web of particular fibers having a particular density;
- 2) a non-absorbent reinforcing layer attached to the web; and
- 3) the reinforcing layer having a particular density.

In particular, the primary reference Bray fails to teach:

- 1) a non-absorbent reinforcing layer *attached to the web* and
- 2) a non absorbent reinforcing layer having a density in the range of 15-40 g/m² (Claim 11) or 20-30 g/m² (Claim 22) of a combined density of about 50 g/m² (Claim 23).

These deficiencies were articulated in applicant's previous response. In addition, Applicant challenged the basis of the rejection. Namely, the Office Action stated that since

alternative embodiments within the specification could support broader ranges than defined by the claims, a reference that teaches – not what is claimed – but what is alternatively disclosed *in the specification* somehow renders the claimed subject matter obvious even though it fails to teach or suggest that claimed subject matter.

ISSUE

*The Examiner's sole argument to maintain the rejection, despite acknowledging that the references fail to teach the ranges claimed is the novel – yet completely unsupported – legal theory that an applicant is somehow **precluded** from claiming a subset of what is disclosed within a patent application, because to do so would permit that Applicant to avoid the prior art.* (See Response to Arguments, Final Office Action of July 23, 2009).

In summary, the basis for the Examiner's conclusion is not only unsupported by US patent law and the rules of practice before the US Patent and Trademark Office, it is also the complete antithesis of over 200 years of common practice in the field of Intellectual Property Law.

The facts are not in dispute; the references fail to teach the claimed subject matter. The contention in the Office Action is that one may ignore the actual claims and instead examine alternative embodiments disclosed within the specification and if *something within the specification* is taught, then the claims are somehow rendered obvious.

The Examiner asserts that “by Applicant disclosing such a large density range of 5 – 200 g/m²; Applicant is demonstrating a lack of criticality in a particular number or range.” In the absence of further support by the Examiner, this is an untenable assertion on its face; however, the originally filed specification set forth, with particularity, preferred specific embodiments consistent with the presently claimed ranges (e.g., page 3, line 28 – 32) in addition to other embodiments with larger ranges. Thus, there is literally no legal support for the Examiner's conclusion that a narrower range may not be claimed from a broader disclosure as a matter of principle. In addition, Applicant has already provided particular embodiments in the original specification consistent with the now claimed ranges rendering the “lack of criticality” argument even less sanguine. MPEP 2163.05

The following is a quotation from the “Response to Arguments” section of the Final Office Action dated July 23, 2009.

If Applicant's are allowed to disclose large ranges and then merely chose very small ranges in order to overcome prior art, then a dangerous precedent would be set, because Applicant would have an almost infinite amount of ranges to chose from for the sole purpose of overcoming prior art, even though their claimed invention may not actually be novel with respect to the prior art." (Emphasis and italics added).

Applicant would certainly prefer to avoid setting any dangerous new precedents; however, we respectfully and politely disagree that as a matter of policy narrowing amendments offered to avoid prior art are either new or dangerous. Of course, if an amendment fails to render the claim patentable – whether with respect to novelty or obviousness – that claim is unpatentable; however, by definition if the claim defines novel and unobvious subject matter it is patentable, regardless of Applicant's infinite ability to select subject matter or their intent in avoiding the prior art. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 USPQ2d 1443, 1448 (Fed. Cir. 1992).

In the present case, there are no 35 USC 112 issues; there are no enablement or written description issues, challenges or rejections. There are no novelty issues. By the Examiner's own admission, there are no obviousness issues; the references do not teach the claimed subject matter. The only issue is the rejection of the pending claims based upon broader, unclaimed subject matter disclosed in the specification.

Applicant respectfully asserts that the pending claims are allowable and that the rejection of record is untenable and must therefore be withdrawn without further cost or delay.

Relevant MPEP Citations and Support

2111.01 Plain Meaning

I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS **>SUCH MEANING IS INCONSISTENT WITH< THE SPECIFICATION

****>**Although< claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation >in light of the specification<.). This means that the words of the claim must be given their

plain meaning unless **>the plain meaning is inconsistent with< the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400°F to 850°F" required heating the dough, rather than the air inside an oven, to the specified temperature.). **

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II. IT IS IMPROPER TO IMPORT CLAIM LIMITATIONS FROM THE SPECIFICATION

"Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment);< *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). See also paragraph *>IV.<, below. **>When< an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language)**, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (see MPEP § 2181- § 2186).

2143.03 All Claim Limitations Must Be Considered

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

II. LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED

When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984) (Claim to a catalyst expressly excluded the presence of sulfur, halogen, uranium, and a combination of vanadium and phosphorous. Although the negative limitations excluding these elements did not appear in the specification as filed, it was error to disregard these limitations when determining whether the claimed invention would have been obvious in view of the prior art.).

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CONCLUSION

Applicant respectfully asserts that the pending claims are in condition for allowance and notice of the same is respectfully requested. The office is authorized to charge any fees actually due and credit any overpayment to deposit account 50-4439.

Respectfully submitted,
Nielsen et al.

Date: October 6, 2009

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